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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,581	02/05/2004	Brian P. Carney	14281.1USU1	2269

7590 01/24/2007  
Merchant & Gould P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903

EXAMINER

OKEZIE, ESTHER O

ART UNIT	PAPER NUMBER
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3652

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/772,581	Applicant(s) CARNEY, BRIAN P.	
	Examiner Esther O. Okezie	Art Unit 3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-64 is/are pending in the application.
- 4a) Of the above claim(s) 61-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 61-64 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/07/2006 has been entered.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 29-60, drawn to a mortarboard, classified in class 294, subclass 3.5.
- II. Claims 61-64, drawn to a method of working cementious mortar at a construction site, classified in class 366, subclass 2.

Newly submitted claims 61-64 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 61-64 recite a method of working cementious mortar at a construction site which was not previously presented.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claims 61-64 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 29-35, 37-50, 52-57, 59, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morsilli US 3,790,201 in view of Tabb US Design Patent 113,023.
2. Re claim 29, 32-35, 39-41, 44, 47-50, 52-57 Morsilli discloses a mortarboard comprising: a generally rectangular sheet material defining a broad, solid, continuous, smooth, substantially flat upper working surface (14) extending generally across the entire width of said sheet material between opposed side edges (24, 26) thereof; said upper working surface being sized and configured to retainably hold an operative quantity of cementitious mortar to be worked by an operator such as by mixing with a trowel or shovel, and being impervious to retain moisture in the mortar (columns 1 and 2); and said sheet material being slightly contoured across said upper working surface in a dished-out manner to form a single continuous arcuate contour across the working surface (see fig 1)

Morsilli appears to show the claimed contour. However, Morsilli does not disclose the exact dimensions claimed. The exact contour shape and size/dimensions would be an obvious matter of design choice dependant upon the amount of mortar one desired to hold within the device. See Specification, page 7, lines 13-21, wherein Applicant discusses the degree, depth, dimensions of the invention can vary. It would have been obvious to one of ordinary skill at the time of the invention to modify the dimensions of the device since such modification would have involved a mere change in size of a component and change in size is generally recognized as being within the level of ordinary skill in the art.

Morsilli discloses a removable handle (32) capable of allowing the mortarboard to be carried in a generally vertical manner when not in operative use. Morsilli does not disclose the sheet of material defining a cut-out handle portion formed entirely through said sheet material adjacent one edge of said material, wherein the cut -out is sized to accept a persons hand. Tabb discloses a tray including cutout area portions forming handles (fig 1). It would have been obvious to one of ordinary skill at the time of the invention to modify the handle of Morsilli as taught by Tabb to form a cut out area portion for the user to easily grip the device.

3. Re claims 30,31,43,45,46,and 60, Morsilli discloses the device may be constructed of any suitable material consistent with its use in holding a supply of mortar such as wood, non-oxidizing metal, or plastic. Morsilli does not describe the material is of a strength to resist breaking or damage when stuck by a hammer or other construction tools. It would have been obvious to one of ordinary skill at the time of the

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invention to construct the device with a material of suitable strength to resist damage when used with conventional tools, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use.

Re claims 37 and 38, Morsilli discloses raised peripheral lip portions (20) along at least three sides of said upper working surface. Morsilli does not disclose the dimensions of these portions. It would have been obvious to one of ordinary skill at the time of the invention to modify the dimensions of the device since such modification would have involved a mere change in size of a component and change in size is generally recognized as being within the level of ordinary skill in the art.

4. Re claims 42 and 59, Morsilli discloses the material is configured so that a front and rear surface of the material will nest together with other mortarboards of like construction, when more than one mortarboard is stacked together (col. 2, lines 64-68).

5. Claims 36 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morsilli US 3,790,201 in view of Malvasio US 5,558,253. Morsilli does not disclose the material includes supporting ribs formed integrally with the material. Malvasio discloses a lightweight and strength reinforced taco plate with reinforcing ribs (12) built into the plate. Morsilli and Malvasio are analogous art because they both include support of various articles by a tray surface and are capable of supporting, carrying, and retaining mortar. It would have been obvious to one of ordinary skill at the time of the invention to modify the device of Morsilli as taught by Malvasio to include reinforcing

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ribs formed integrally into the device in order to "... strength-reinforce the plate and protect it from abnormal twisting or certain bending..." (Malvasio: col. 2, lines 50-56).

6. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morsilli US 3,790,201 in view of US Patent Application Publication 2004/0150236 A1 of Hobel et al. Morsilli does not disclose the bottom surface configured to accommodate a support stand. Hobel et al discloses a mixing palette including a bottom surface that is configured to accommodate a support stand (see figs 4a, 4b, and 5 for palette on support stand). It would have been obvious to one of ordinary skill at the time of the invention to modify the device of Morsilli to include a bottom surface configured to accommodate support on a support stand in order to support the device during use.

### ***Response to Arguments***

Applicant's arguments with respect to claims 29-64 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Esther O. Okezie whose telephone number is (571) 272-8108. The examiner can normally be reached on Mon-Thurs 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EOO 1/3/07



**EILEEN D. LILLIS**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600